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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,272	12/19/2000	Charles Raymond Degenhardt	8371	6508

27752 7590 01/07/2004

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CINCINNATI, OH 45224

EXAMINER

MCKENZIE, THOMAS C

ART UNIT	PAPER NUMBER
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1624

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DATE MAILED: 01/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/741,272

Applicant(s)

DEGENHARDT ET AL.

Examiner

Thomas McKenzie, Ph.D.

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 32-39 is/are pending in the application.
- 4a) Of the above claim(s) 33-36 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 32 and 37-39 is/are allowed.
- 6) ☒ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

1. This action is in response to amendments filed on 10/27/03. Applicant has canceled claims 2, 4, 9, 11, 18-25, and 27-31. Claims 32-39 are new. There are eight claims pending and four under consideration. Claims 32 and 37 are compound claims. Claim 38 is a composition claim. Claim 39 is a use claim. This is the fifth action on the merits. The application concerns some 2-heterocyclylcarbonyl-piperidines.

***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/27/03 has been entered.

***Response to Amendment***

3. Applicants' deletion of claim 9 renders moot the point concerning withdrawn claims made in point #3 of the previous Final rejection. Applicants' new claims omitting "about" in reference to atom count overcome the indefiniteness rejection made in point #4. Applicants' deletion of the proviso from their new claims overcomes the written description rejection made in point #5.

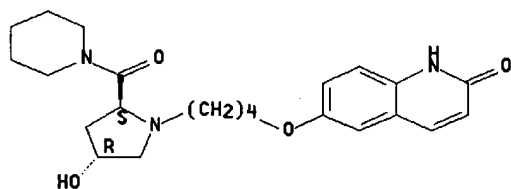
***Election/Restrictions***

4. Newly submitted claims 33-36 are directed to inventions that are independent or distinct from the invention originally claimed for the following reasons: the formula of claim 32, and the formula that was searched in the prior actions has a piperidinyl carbonyl group, possibly linked through a methylene chain when  $x$  is not zero, attached to the heterocycle ring A at the carbon atom adjacent to the ring nitrogen atom of heterocycle A (position 2). The piperidinyl ring must be formed through radicals  $R^2$  and  $R^3$ . The formulas of claims 33 and 35 have the piperidinyl carbonyl group, formed through radicals  $R^2$  and  $R^3$ , in the 3-position of ring A, two carbon atoms removed from the nitrogen atom of ring A, not in the 2-position of ring A. Claims 34 and 36 suffer from the same positional defect but additionally have a cyclohexane, not the required piperidine bonded to the carbonyl group. In claims 34 and 36, ring A is the ring bearing radical  $R^4$  and the ring formed from  $R^2$  and  $R^3$  is just to the right of the carbonyl group.

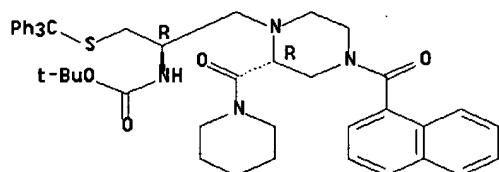
Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 33-36 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

**Statement of Reasons for Allowance**

5. Claims 32 and 37-39 are allowed. The following is an Examiner's statement of reasons for allowance: Applicants compounds are novel over Sato ('239). The compound shown below fits the formula of claim 32 with  $R^5 = O_rR^6$ ,  $r = 1$ ,  $R^6 =$  the heteroaromatic aromatic group 1,2-dihydro-2-oxo-6-quinoliny,  $t = 3$ ,  $R^4 = CH(R^1)$ ,  $R^1 =$  hydrogen,  $A =$  pyrrolidine,  $w = 1$ ,  $R^8 =$  the heterogeneous group hydroxyl, and  $NR^2R^3 =$  piperidine. However, the piperidine ring is not substituted as required by Applicants claims.

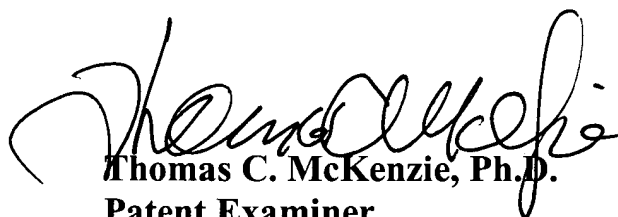


6. Applicants' compounds are novel over Graham ('539). The compound shown below fits the formula of claim 32 with  $R^5 = NR^6(R^7)$ ,  $R^6 =$  the substituted heterogeneous group 1,1-dimethylethylcarbamoyl,  $R^7 =$  hydrogen,  $t = 1$ ,  $R^1 =$  substituted heterogeneous group (triphenylmethyl)thio]methyl,  $R^4 = CH(R^1)$  with  $R^1 =$  hydrogen,  $A =$  piperazine,  $w = 1$ ,  $R^8 =$  the substituted aromatic group 1-naphthalenylcarbonyl, and  $NR^2R^3 =$  piperidine. However, the piperidine ring is not substituted as required by Applicants claims.



***Conclusion***

7. Please direct any inquiry concerning this communication or earlier communications from the Examiner to Thomas C McKenzie, Ph. D. whose telephone number is (703) 308-9806. After February 9, 2004, the Examiner may be reached at (571) 272-0670. The FAX number for amendments is (703) 872-9306. The PTO presently encourages all applicants to communicate by FAX. The Examiner is available from 8:30 to 5:30, Monday through Friday. If attempts to reach the Examiner by telephone are unsuccessful, you can reach the Examiner's supervisor, Mukund Shah at (703) 308-4716. Please direct general inquiries or any inquiry relating to the status of this application to the receptionist whose telephone number is (703) 308-1235.

  
Thomas C. McKenzie, Ph.D.  
Patent Examiner  
Art Unit 1624

TCMcK